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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,429	04/01/2004	Todd A. Berg	1001.1217103	8806
28075 7590 03/18/2009 CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			EXAMINER HUSON, MONICA ANNE	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 03/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/816,429

Applicant(s)

BERG ET AL.

Examiner

MONICA A. HUSON

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-48 is/are pending in the application.
- 4a) Of the above claim(s) 34, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33, 35 and 38-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to the RCE filed 23 February 2009.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Lunn (U.S. Patent 5,509,910). Lunn shows that it is known to carry out a method of providing a transition region in a guide catheter (Abstract), the method comprising removing a portion of the outer layer (Column 5, lines 37-45), replacing the removed section of the outer layer with a different polymer to form the transition region (Column 6, lines 25-40), wherein the transition region has a flex modulus that is different from that of the distal and proximal region (Column 7, lines 14-67; Column 8, lines 1-20).

Claims 40-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Noone et al. (U.S. Patent 6,591,472). The examiner notes that applicant has claimed priority to 14 February 1994, however it is believed that the subject matter in claims 33, 35, and 38-48 does not have clear support the document filed 14 February 1994. Therefore, the earliest date for support being 18 May 1999, Noone et al. is available as prior art under 35 USC 102(e). See Advisory Action, mailed 14 January 2009 for further discussion. Noone et al., hereafter "Noone," show that it is known to carry out a method of molding a guide catheter, including removing a portion of the outer layer near the transition region, replacing the removed portion with a different polymer, wherein the transition region has a different flex modulus than the distal and proximal region (Figures 2-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lunn.

Regarding Claim 35, Lunn shows the process as claimed as discussed in the rejection of Claim 33 above, but he does not show forming annular grooves. However, changing the shape of the cut would be a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (MPEP 2144.04 (IV)(B)). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form any configured cut during Lunn's molding process in order to increase bonding efficiency with the next segment.

Regarding Claims 38-39, Lunn shows the process as claimed as discussed in the rejection of Claim 33 above, including noting that the selection of the transition section polymer is based upon considerations of the catheter shaft itself, suggesting that the material of the transition section can be chosen from a variety of materials with varying modulus's (Column 7, lines 14-67; Column 8, lines 1-20). Therefore, It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to select a polymer of lower flex modulus or higher flex modulus than the removed section, depending on any particular end-use specification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONICA A. HUSON whose telephone number is

(571)272-1198. The examiner can normally be reached on Monday-Friday 7:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica A Huson
Primary Examiner
Art Unit 1791

/Monica A Huson/
Primary Examiner, Art Unit 1791